



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,699	11/10/2003	John W. Devault	47079-00090USP1	5232
70243 7590 08/28/2008 NIXON PEABODY LLP 161 N CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER SAGER, MARK ALAN	
			ART UNIT	PAPER NUMBER
			3714	
			MAIL DATE	DELIVERY MODE
			08/28/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/705,699

Applicant(s)

DEVAULL ET AL.

Examiner

M. Sager

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-9,11,12,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-9,11,12,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. Claims 1, 8-9 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker (6068552). Walker discloses gaming machine and method including a value input device for receiving a wager (figs. 1-9A), a processor (fig 1) operative to accumulate bonus points based on predetermined criteria (implicit for casino reward program, 10:43-51), allow player to redeem a number of the bonus points for one of a plurality of player selectable options at a time selected by the player, the options including immediately specified credit amount (implicit, 10:43-51, specified amount is free beverage/meal, free room or room upgrade, theatre tickets, etc. as conventional for loyalty program with respect to exchange bonus points earned from gaming activity for prize that have a fixed value) and a bonus game feature for determining a random award (10:43-51) for improved odds of obtaining jackpot in a chance game whereby the value won is greater than, equal to or less than the specified credit amount.

Claim Rejections - 35 USC § 103

2. Claims 5-7, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher (6726563) in view of either Acres ('125) or Kelly ('918). This holding is maintained from prior action as reiterated herein for cited claims as amended. Response to arguments is provided below and incorporated herein. Baerlocher discloses a method and gaming machine (figs 1-8) teaching claimed steps/features including a value input device for receiving a wager (3:59-4:7), a processor for accumulating bonus points based on predetermined criteria and allowing the player to redeem a number of bonus points for an award at a time selected by the player such as during any game play cycle (2:10-3:10, 4:48-5:35, 5:60-11:36, fig 108, ref 40) wherein the player may redeem for one of a plurality of player selectable options (2:20-3:10, fig

1-8), wherein the plurality of possible options include a game feature including a plurality of bonus game features worth different numbers of bonus points and wherein the game features are interactive as a plurality of player-selectable elements (2:20-3:10, figs 1-8, esp. fig 3-8, ref 34, 62, 64, 66, 68, 70, 72, 108, 110, 112, 114, 116, 118, 120, 122, 124, 126). Alternatively, where Baerlocher '563 redeems accumulated points for a credit amount (various award values shown in figs. 3, 5-8) as a bonus, Baerlocher discloses claimed steps/features including a plurality of player selectable elements as key holes that provide a random credit amount but, as best understood, appears to lack either an immediately specified credit amount. However, Acres (12:65-13:8, 14:25-37 and 54-59) or Kelly (3:13-16, 22-23, 7:33-39, 8:25-28, 21:59-61, 27:47-50) each disclose a gaming machine and method teaching accumulating points that may be redeemed for a free game/spin that is a fixed credit amount. While Acres accumulated points relate to patron or loyalty points won/earned based on play of game, Kelly accumulated points relate to points won based on performance or outcome of game play, but each suggests converting earn/won points to a fixed credit amount such as for a free game/spin that has an equivalent fixed cash or credit value such that in each Acres and Kelly player elects to redeem points such as by converting to credit amount during any play. A free game/spin may also be a bonus game feature such as taught by Kelly. All of the component parts are known in Baerlocher, Acres and Kelly. The only difference is the combination of 'old elements' into a single device by allowing a player to select among a plurality of options for an award that include a specified credit amount or a bonus game feature; however, as shown, Baerlocher allows a player to select among a plurality options of multiple features for bonus game feature; while, Acres or Kelly each allow a player to select a plurality of fixed credit amount based on

earned points. Thus, in further consideration of Supreme Court decision in KSR, it would have been obvious to an artisan at a time prior to the invention to apply the process of immediately specified credit amount as known or as taught by either Acres or Kelly to gaming machine and method of Baerlocher to achieve predictable results of allowing player option to selectively redeem points won/earned. It is noted that the pricing of awarding points converted is also taught by combination. In essence, the option claimed is between a fixed credit value and a random/unknown credit value as covered by the breadth of claim language 'bonus points' includes and does not preclude points won or earned as taught/suggested by Baerlocher as combined with either Acres or Kelly.

Response to Arguments

3. Applicant's arguments filed 6/2/08 have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Applicant argues that what each reference of prior art lacks individually on page 6 but does not address what the combination when taken as a whole at a time prior to the invention suggests to an artisan as required by law that is as shown in holding. Of note, Applicant states that Baerlocher gives the player the option to select one of three games based on number of keys earned and that Acres and Kelly each provide the player the option to redeem bonus points for prizes. The Office maintains, with due consideration of KSR decision, that it would have been obvious to an artisan at a time prior to the invention to apply the process of immediately specified credit amount as

taught/suggested by either Acres or Kelly to improve the process and gaming machine of Baerlocher for the predictable result of player selection of award as stated above incorporated herein.

4. Applicant's arguments with respect to claims 1, 8-9 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baerlocher '573 includes player selection of bonus from multiple envelopes.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/
Primary Examiner, Art Unit 3714